


**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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 Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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00/404,840

12/16/99

NORMAN

R

13755PTUSW

BY: FOR

H022/1122

EXAMINER

MARKIN S. ROYCE

13755PTUSW

30 ROCKEFELLER PLAZA

ART UNIT

PAPER NUMBER

NEW YORK, N.Y. 10117

13755

5

DATE MAILED:

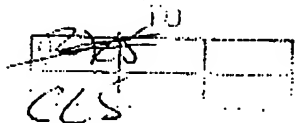
11/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

BAKER BOYD L.L.P.

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 Docketed  
 For 12122-12000 5/22/01

 COPY TO  
 CLS 12/7/02

**Office Action Summary**

Application No.

09/464,840

Applicant(s)

Hanash et al

Examiner

Anne Holleran

Group Art Unit

1642


☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claim**
☒ Claim(s) 1-21 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-21 are subject to restriction or election requirement.
**Application Papers**
☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.
**Priority under 35 U.S.C. § 119**
☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been

☐ received

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
**Attachment(s)**
☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4 and 10-14, drawn to methods of identifying proteins and methods of diagnosis for the presence of cancer, classified in class 435, subclass 4 and class 436, subclass 64.
  - II. Claims 5-9, drawn to methods of diagnosis and prognosis of cancer comprising detecting autoantibodies, classified in class 435, subclass 7.1, class 530, subclass 387.1.
  - III. Claims 15-17, drawn to methods of stimulating in a subject an immune response, classified in class 514, subclass 2.
  - IV. Claims 18-21, drawn to compositions comprising a protein identified in method of claim 1, classified in class 530, subclass 350.

2. The inventions are distinct, each from the other, for the following reasons:

Each of inventions I, II and III is directed to a separate and distinct process. Each of the processes are distinct both physically and functionally, require different steps and make or use different products. Invention groups I and II are materially different from Invention group III because each of invention groups I and II are directed to in vitro methods which are materially different from the in vivo methods of treatment of invention group III. Invention groups I and II

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are separate and distinct inventions from each other because the methods of group I are directed to the detection of serum proteins which produce autoantibodies and the methods of group II are directed to the detection of autoantibodies. Thus, each of these methods would require different steps and different reagents.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the inventions of group III can be used in an in vitro method to detect antibodies which is a materially different process from the process of invention group III.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and recognized divergent subject matter and because searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Anne Holleran, Ph.D. whose telephone number is (703) 308-8892.

Examiner Holleran can normally be reached Monday through Friday, 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached at (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

*ALH*

Anne L. Holleran  
Patent Examiner  
November 20, 2000

*Brenda Brumback*  
BRENDA BRUMBACK  
PATENT EXAMINER

## FILING RECEIPT



\*OC000000005151555\*

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark OfficeAddress: ASSISTANT SECRETARY AND  
COMMISSIONER OF PATENT AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/464,840	12/16/1999	1643	454	31755PCTUSA0	7	21	2

21003  
BAKER & BOTTS  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

Date Mailed: 06/01/2000

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the PTO processes the reply to the Notice, the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

SAMIR M. HANASH, ANN ARBOR, MI ;  
DAVID MISEK, ANN ARBOR, MI ;  
ROBERT HINDERER, FLINT, MI ;  
LATHA PRASANAN, ANN ARBOR, MI ;

## Continuing Data as Claimed by Applicant

THIS APPLICATION IS A CON OF PCT/US98/13295 06/26/1998  
AND CLAIMS BENEFIT OF 60/050,832 06/26/1997

## Foreign Applications

If Required, Foreign Filing License Granted 02/03/2000

\*\* SMALL ENTITY \*\*

## Title

METHOD FOR IDENTIFICATION OF CELLULAR PROTEIN ANTIGENS AND PRESENCE OF  
ANTIBODIES TO SPECIFIC CELLULAR PROTEIN ANTIGENS IN SERUM

## Preliminary Class

435

Data entry by : WYATT, DEBRA

Team : OIPE

Date: 06/01/2000

1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 31 32 33 34 35 36 37 38 39 40 41 42 43 44 45 46 47 48 49 50 51 52 53 54 55 56 57 58 59 60 61 62 63 64 65 66 67 68 69 70 71 72 73 74 75 76 77 78 79 80 81 82 83 84 85 86 87 88 89 90 91 92 93 94 95 96 97 98 99 100

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**Title 37, Code of Federal Regulations, 5.11 & 5.15**

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**NOT GRANTED**

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- The words "new," "improved," "improvements in" or "relating to" are not included as first words in the title of an application because a patent application, by nature, is a new idea or improvement.
- The title may be truncated if it consists of more than 600 characters (letters and spaces combined).
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